



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal Brief
12/15/03

In re Application of:

MICHAEL WAYNE BROWN, ETAL.

Serial No.: 09/534,595

Filed: MARCH 27, 2000

For: MAINTAINING
CONFIDENTIALITY OF PERSONAL
INFORMATION DURING E-
COMMERCE TRANSACTIONS

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Examiner: RUDY, ANDREW J.

Art Unit: 3627

APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in triplicate in support of an Appeal of the Examiner's final rejection of Claims 1, 2, 4-8, 10-12 and 14-17 in the above-identified application. A Notice of Appeal was filed in this case on October 8, 2003 and received in the Patent Office on October 14, 2003. Please charge the fee of \$330.00 due under 37 C.F.R. § 1.17(c) for filing the brief, as well as any additional required fees, to **IBM DEPOSIT ACCOUNT NO. 09-0447**.

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12/15/03
Date

Shenise Raudel
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REAL PARTY IN INTEREST

As evidenced by the Assignment set forth at Reel 010712, Frame 0664, the present application is assigned to International Business Machines Corporation, the real party in interest for the present Appeal.

RELATED APPEALS AND INTERFERENCES

An Appeal of co-pending and related U.S. Patent Application, No. 09/535,559, which appeal was filed on December 15, 2003, directly affects or would be directly affected by or have a bearing on the Board's decision in the present Appeal. There are no other Appeals or Interferences known to Appellants, the Appellants' legal representative, or assignee, which would be directly affected or have a bearing on the Board's decision in the present Appeal.

STATUS OF CLAIMS

Claims 1, 2, 4-8, 10-12 and 14-17 stand finally rejected by the Examiner as noted in the **Final Office Action dated May 29, 2003.**

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final rejection that leads to this appeal.

SUMMARY OF THE INVENTION

As provided by the specification and claims, Appellants' invention provides a method and system for completing e-commerce transactions (including shipping) while maintaining (1) confidentiality of personal information of a first party buyer from a second party merchant and (2) confidentiality of financial information from a third party shipper (see page 18, lines 3-7, which describes the three party interaction). The buyer is provided with a unique transaction identifier (TID) (page 17, lines 1-2) that is utilized during transactions with the seller, who only receives the TID to identify the buyer (i.e., the seller does not receive any personal information about the buyer) (page 18, lines 27-30 and page 19, lines 11-19). A unique security routing ID (SRID) is also provided that enables items to be shipped by a third party to the buyer with only

an exchange of the TID and SRID. The SRID provides the independent shipper (a third party not directly affiliated with the seller) with the shipping details (address, etc.) of the buyer (page 17, lines 19-28; see also page 22, lines 21-29; line 34-page 23, line 1). The buyer's financial information is not provided to the shipper.

As provided within the claims, Appellants' invention involves a first transaction between a first party and a second party via an electronic depository. The electronic depository maintains personal and other (credit card, etc.) information of the parties, none of which is transmitted during the actual e-commerce transaction (i.e., only the TID is transmitted between parties). Each potential buyer has a unique TID, which is also utilized to identify the buyer and trigger correct payment and shipment, following completion of a transaction. The exchange of payment, etc. and assignment of the TID is completed at a background depository that is not affiliated with the buyer or seller. The TID is also utilized by a shipper to request the address information of the buyer using the TID.

Applicants' invention also involves a second transaction between the second party and the shipper (defined as an independent entity from the second party). In the second transaction, an SRID is provided by the second party to the shipper along with the TID. The shipper then utilizes these IDs to respectively (1) identify the item to be shipped, and (2) obtain required addressing information of the first party from the depository. Notably, the second transaction involves an electronic exchange of these transaction-related/generated IDs that results in the shipment of an actual physical (or electronic) item without the second party receiving specific personal data on the first party or the shipper receiving credit card/payment information of the first party.

ISSUES

The primary issue for appeal is whether Claims 1, 2, 4-8, 10-12 and 14-17 are unpatentable under 35 U.S.C. § 103(a) over Vaghi (U.S. Patent No. 6,047,273). Resolution of that issue, however, depends on a determination whether Vaghi suggests to one skilled in the art the various functional features, as is recited by exemplary Claim 1, including the TID, SRID, and e-commerce transaction and shipping with an exchange of only the TID and SRID.

GROUPING OF THE CLAIMS

For purposes of this Appeal claims 1, 2, 4-8, 10-12 and 14-17 stand or fall together as a single group.

ARGUMENT

The present Appeal is filed in response to the Examiner's Final Action dated **May 8, 2003** in which Claims 1, 2, 4-8, 10-12 and 14-17 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Vaghi, et al. (U.S. Patent No. 6,047,273). That rejection is not well founded and should be reversed.

Exemplary Claim 1 of Appellants' invention provides a method for maintaining confidentiality during E-commerce transactions including the following steps: (1) "compiling a profile of personal information" at an electronic depository; (2) "providing a unique transaction identifier (TID) linked to said profile"; and (3) "completing said transaction utilizing said electronic depository without said second party receiving...said personal information of said first party."

Exemplary Claim 1 also provides: (4) "assigning a security routing identifier (SRID)...to identify a shipment of said item by a shipping service affiliated with said electronic depository, ...independent of said second party and...transfer of said item to an address of said first party, and...to the second party, who forwards the item along with said SRID and said TID to the shipping service"; and, after receiving the TID and SRID (at the depository) from the shipping service; (5) "forwarding at least an address portion of said profile associated with said TID to said shipping service..., wherein said shipping service ... subsequently sends said item to said first party utilizing at least said address portion of the profile."

Vaghi clearly does not suggest to one skilled in the art the above features, particularly (1) a first party transaction identifier (TID), (2) a security routing identifier (SRID) for identifying particulars of a shipment by a shipping service that is independent of the second party or (3) specific implementation of shipping service via TID and SRID exchange.

Vaghi primarily discusses purchasing **updates** to an internet-accessible shipping service via online ordering of the updates directly from the shipping service and downloading the updates to a locally stored shipping application. Sections cited by Examiner (i.e., col. 3, line 44-48, cols 5-7, and col. 8, lines 15-27) describe the features related to this purchasing of updates to the shipping service (see particularly col. 7, line 15-52). These sections provide no discussion or suggestion of E-commerce transactions involving two parties where a third party “shipper” is utilized to ship the purchased item once the transaction is completed between the e-commerce participants. Those sections are also not suggestive of using unique IDs (TID and SRID) to complete the two parts of the purchase transaction, i.e., the buyer-to-seller buying exchange and the seller-to-shipper shipping exchange.

Vaghi also does not suggest providing a depository for storing all personal information of at least a first party and providing a unique transaction ID for the first party so that (1) specific personal information such as credit card information, etc. is never displayed to the second party or shipper; (2) the shipment of an actual physical (or electronic) item is completed (via the shipper) without the second party having specific personal data of the first party; or (3) access to financial information is not provided to the shipper (only address information to ship the identified item).

From Examiner’s statements in paragraph 3 of the Office Action, it appears that Examiner has failed to fully understand the functional features and participants involved with the implementation of Applicants’ invention. Notably, Examiner assumes that the shipper is synonymous with the second party of the E-commerce transaction rather than an independent, separate entity that is not directly involved in the buying exchange of the E-commerce transaction. Thus, Examiner incorrectly concludes that Vaghi’s description of selecting a shipping method in cols. 5-7 is synonymous with or suggestive of Appellants’ use of the SRID and an independent third party shipper and related functionality.

Also, Examiner incorrectly concludes that (1) “[i]t is common knowledge that when selecting a carrier to ship...unique identifier is issued to associate the product with the entity

ordering the goods/services,” and (2) that the shipping entity is given “only a transaction identifier, when executing its delivery function.” Appellants respectfully disagree with these assertions. Examiner provides no support for these conclusory statements, which are contrary to conventional operation of shipping services that are provided personal and financial information of the intended recipient (buyer) following a standard purchase transaction. Vaghi clearly does not teach or suggest these unique features of Appellants’ claimed invention.

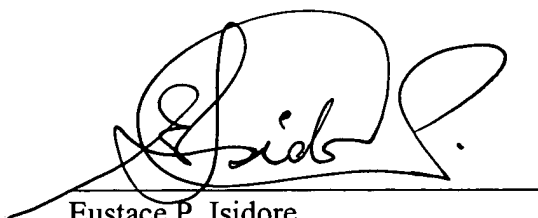
Notably, also, Applicants’ invention provides the depository to prevent transmission/exchange of personal information during the actual purchase transaction, Vaghi clearly describes transmission of personal information as a main part of its transaction. Vaghi at col.8, lines 15-27 provides: “the payment information is encrypted for security purposes, and then transmitted to the MSSSPC to purchase modification of the selected features.” One skilled in the art would realize that providing a transaction identifier in lieu of actual personal/financial information is inherently distinct from transmitting the actual information in encrypted form, then decrypting the information for use by the seller.

It is clear that Vaghi fails to suggest the key features of Appellants’ invention. Appellants have provided arguments indicating why the Examiner has not established prima facie obviousness of the present invention. Thus, Appellants believe that exemplary Claim 1 and all other pending claims are not rendered unpatentable by the cited references and should be allowed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language, which renders the invention patentable over the reference. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. Isidore', is written over a horizontal line.

Eustace P. Isidore

Registered with Limited Recognition (see attached)

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ATTORNEY FOR APPELLANT(S)

APPENDIX

1. (previously presented) A method for maintaining confidentiality of personal information during E-commerce transactions comprising the steps of:

compiling a profile of personal information within an electronic depository for at least a first party to an E-commerce transaction;

providing said first party a unique transaction identifier (TID) linked to said profile for use during said E-commerce transaction; and

in response to said first party providing said transaction identifier to a second party to said E-commerce transaction, completing said transaction utilizing said electronic depository without said second party receiving at least a portion of said personal information of said first party; and

wherein, when said transaction requires a transfer of an item from the second party to the first party, said completing step includes:

assigning a security routing identifier (SRID) for utilization by said second party to identify a shipment of said item by a shipping service affiliated with said electronic depository, wherein the shipping service is independent of said second party and is utilized to complete said transfer of said item to an address of said first party, and wherein said SRID is initially provided to the second party, who forwards the item along with said SRID and said TID to the shipping service;

receiving said transaction identifier along with said security routing identifier at said depository from said shipping service; and

forwarding at least an address portion of said profile associated with said TID to said shipping service along with said SRID, wherein said shipping service receives the item from said second party tagged with only said SRID and said TID for identification purposes and subsequently sends said item to said first party utilizing at least said address portion of the profile.

2. (original) The method of Claim 1, wherein said first party is a buyer and said second party is a merchant having a web server for initiating E-commerce transactions, and said

completing step further includes the step of locating said transaction identifier in said electronic depository.

3. (canceled)

4. (previously presented) The method of Claim 2, wherein said receiving step includes the step of automatically notifying said buyer of a receipt of said transaction information.

5. (previously presented) The method of Claim 2, wherein said product for said transaction is electronic and said receiving step further includes the step of electronically receiving said product at said depository and then transmitting said product to said buyer.

6. (original) The method of Claim 1, wherein said step of providing a unique transaction identifier comprises the step of providing a credit card number.

7. (previously presented) The method of Claim 1, wherein said second party is provided a unique second-party TID, said method further comprising the steps of completing said E-commerce transaction on a server of said electronic depository wherein said transaction is completed on said server without said first party and said second party receiving any of said personal information of the other party.

8. (previously presented) A client-based method for maintaining confidentiality of personal information during E-commerce transactions comprising the steps of:

creating a profile of personal information within an electronic depository for at least a first party to an E-commerce transaction, wherein said first party is provided a unique transaction identifier (TID) linked to said profile for use during said E-commerce transaction;

enabling said first party to select whether or not to provide said TID in lieu of personal information to said second party; and

in response to said first party providing said transaction identifier to a second party to said E-commerce transaction, forwarding information related to said E-commerce transaction to

said electronic depository, wherein said transaction is completed by said electronic depository without said second party receiving any of said personal information.

9. (canceled)

10. (previously presented) The method of Claim 9 8, wherein said enabling step further comprises the step of providing a web browser application having a graphical user interface (GUI) on an Internet access system of said client, wherein said GUI provides a plurality of selectable options for said first party including utilizing a transaction identifier to complete said E-commerce transaction.

11. (previously presented) A system for maintaining confidentiality of personal information during E-commerce transactions, said system comprising:

an electronic depository utilized for storing a profile of personal information for at least a first party to an E-commerce transaction;

registration utility affiliated with said depository for assigning said first party a unique transaction identifier (TID) linked to said profile for use during said E-commerce transaction; and

transaction utility affiliated with said depository for completing said E-commerce transactions utilizing said electronic depository in response to said first party providing said transaction identifier to a second party to said E-commerce transaction, wherein said second party receives only a portion of said personal information of said first party required to complete the transaction;

wherein, when said transactions requires a transfer of an item from the second party to the first party, said transaction utility further includes:

means for assigning a security routing identifier (SRID) for utilization by said second party to identify a shipment of said item by a shipping service affiliated with said electronic depository, wherein the shipping service is independent of said second party and is utilized to complete said transfer of said item to an address of said first party, and wherein said SRID is initially provided to the second party, who forwards the item along with said SRID and said TID to the shipping service;

means for receiving said transaction identifier along with said security routing identifier at said depository from said shipping service; and

means for forwarding at least an address portion of said profile associated with said TID to said shipping service along with said SRID, wherein said shipping service receives the item from said second party tagged with only said SRID and said TID for identification purposes and subsequently sends said item to said first party utilizing at least said address portion of the profile.

12. (original) The system of Claim 11, wherein said first party is a buyer and said second party is a merchant having a web server for initiating E-commerce transactions, and said transaction utility includes means for locating said transaction identifier in said electronic depository.

13. (canceled)

14. (previously presented) The system of Claim 12, wherein said receiving means includes means for automatically notifying said buyer party of a receipt of said transaction information.

15. (previously presented) The system of Claim 12, wherein said product for said transaction is electronic and said receiving means further includes electronically receiving said product at said depository and then transmitting said product to said buyer.

16. (original) The system of Claim 11, wherein said registration utility which provides a unique transaction identifier comprises means for providing a credit card number.

17. (original) The system of Claim 12, wherein said second party is provided ~~also has~~ a unique second-party TID, said system further comprising means for completing said E-commerce transaction on a server of said electronic depository wherein said transaction is completed on said server without said first party and said second party receiving any of said personal information of the other party.

18-28. (canceled)

**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Eustace P. Isidore is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Bracewell & Patterson, LLP to prepare and prosecute patent applications and to represent applicants wherein the patent applicants are clients of Bracewell & Patterson, LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Bracewell & Patterson, LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Eustace P. Isidore ceases to lawfully reside in the United States, (ii) Eustace P. Isidore's employment with Bracewell & Patterson, LLP ceases or is terminated, or (iii) Eustace P. Isidore ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: May 8, 2004



Harry Moatz,
Director of Enrollment and Discipline